

Attorney Docket No.: SJ-0011  
Inventors: Danks et al.  
Serial No.: 09/622,568  
Filing Date: August 31, 2000  
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#### REMARKS

Claims 1-22 are pending in the instant application. Claims 1-22 have been canceled. Claims 23-31 have been added. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of these amendments and the following remarks.

Claims 1-22 have been subjected to a Restriction Requirement as follows:

Group I, claims 1-6 and 8-11, drawn to polynucleotides encoding carboxylesterase and vectors and host cells comprising these polynucleotides and methods of use thereof for sensitizing tumor cells to a chemotherapeutic prodrug;

Group II, claim 7, drawn to a carboxylesterase;

Group III, claims 12, 13 and 17, drawn to methods of inhibiting tumor growth;

Group IV, claims 14 and 15, drawn to methods of inhibiting tumor recurrence;

Group V, claim 16 drawn to a method of purging bone marrow cells;

Group VI, claims 18 and 19, drawn to methods of identifying drugs activated by a carboxylesterase;

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Group VII, claims 20-22, drawn to a method for delivering carboxylesterases to selected tumor cells.

The Examiner suggests that these Groups I-VII as set forth above are distinct, each from the other, because each invention is directed to divergent subject matter with different features. Applicants respectfully traverse this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

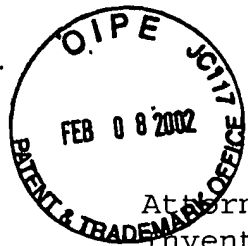
All of claims of the instant application relate to the concept of a method of using carboxylesterases to promote the conversion of a prodrug into an active drug in a cell or organism. Accordingly, each of the claims contain the components for use in the same endpoint - namely conversion of a prodrug into an active drug in a cell or organism. Thus, Applicants respectfully disagree that the

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Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01.

In an earnest effort to facilitate the prosecution of this application and to clarify the inventive concept of the invention, Applicants have canceled claims 1-22. Applicants do not believe that any of the Groups set forth by the Examiner adequately and concisely represent the true inventive concept of the instant application. Applicants are re-presenting the intended subject matter of the invention, namely a method of carboxylesterase use to promote conversion of a prodrug into an active drug in a cell or organism, in new claims 23-31. Support for new claims 23, 25, 26, and 27 can be found throughout the specification and particularly at page 23, lines 8-21, page 24, lines 20-25, and Figure 8. Support for new claims 24-27 can be found throughout the specification and particularly at page 10, lines 12-17, page 13, lines 22-30. Support for the method of administration in claims 28-31 can be found throughout the specification and especially on pages 13 and 21.

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.



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Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 1-22 have been canceled.